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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

016295.0624

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on 05/29/07

Signature

Typed or printed name

Laura D. Crane

Application Number

09/768,665

Filed

01/24/01

First Named Inventor

Tuyet-Huong Thi Nguyen

Art Unit

2111

Examiner

Dang, Khanh

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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attorney or agent of record.

Registration number 39,678

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

Signature

Roger Fulghum

Typed or printed name

713-229-1707

Telephone number

May 29, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

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*Total of one (1) forms are submitted.

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REMARKS

In the prosecution of the present Application, the Examiner's rejections and assertions contain clear errors of law, including a failure to establish *prima facie* rejections in a Final Office Action. To assist the Panel in the review of this Request, applicants submit the following brief summary of selected portions of the prosecution history of the Application.

I. Errors of Record

a. Failure to Establish a Prima Facie Rejection - Improper Combination with Goodman

The Final Office action mailed December 27, 2006 rejected pending claims 1, 4-8, 16, and 19-23 under 35 U.S.C. § 103(a). The Final Office Action states at page 10

In response to Applicants' argument, while the Examiner agrees with Applicants that Goodman discloses dedicating the boot processor to handle the interrupt management, Applicants are reminded that the rejection is based on a combination of references. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

Applicants would like to reiterate that, in this case, the combination of references relied upon by the Examiner is **improper due to Goodman**. References may not be combined unless there is some **motivation or suggestion** in the prior art for the combination. In particular, references *cannot be combined* if their combination would *teach away* from the claimed invention. Applicants have focused on Goodman to demonstrate that Goodman *teaches away* from the claimed invention, and thus, any combination of references involving Goodman is improper. A *prima facie* case of obviousness has not been established by the Examiner because the Examiner relied on this improper combination of references involving Goodman.

Here, the asserted prior art identified by the Examiner *cannot* properly be combined with Goodman because Goodman *teaches away* from the invention. A reference teaches away from the invention when a person of ordinary skill in the art, upon reading the reference, would be led down a path that is divergent from the path of the patent applicant. See *Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 192 F.3d 1353 (Fed. Cir. 1999); *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994) (explaining that a reference teaches away if it suggests a line of development that is unlikely to produce the result sought by the applicant). It is improper to

combine references that teach away from their combination. In re Grasselli, 713 F.2d 731 (Fed. Cir. 1983); MPEP 2145.

Goodman teaches away from the claimed invention by *expressly* providing that all system management interrupts are to be handled by a **single, dedicated** processor. Goodman plainly discloses that “only the boot processor” is to be involved in handling system management interrupts (column 4, line 57). There is no teaching from Goodman to suggest that *any* processor other than the single boot processor is operable to handle a system management interrupt. Nowhere does Goodman suggest that multiple processors could be used to handle system management interrupts, as explicitly claimed in the present application. A plain reading of Goodman would lead a person of ordinary skill to conclude that only a **single, dedicated** processor is responsible for handling a system management interrupt, in direct contrast to the claims of the present invention.

Applicants would like to emphasize that Goodman must be considered in its **entirety**. It is well established that a prior art reference must be considered in its entirety, including those portions that point to the nonobviousness of the invention at issue. The relevant section of the MPEP, 2141.02, states that “[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” (emphasis in original). This section of the MPEP includes a detailed discussion of the W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1550-51 (Fed. Cir. 1983) case, and the fact that the reference discussed in that case, when read as a whole, would not suggest the claimed invention. In re Hedges, 783 F.2d 1038 (Fed. Cir. 1986), the Federal Circuit plainly stated that “the prior art as a whole must be considered.” *Id.* at 1041. “[I]t is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” In re Wesslau, 353 F.2d 238, 241 (CCPA 1965).

Here, when considering the teachings of Goodman as a whole, a person of ordinary skill would be encouraged to use only a **single, dedicated** processor as the processor responsible for handling a system management interrupt. When considered as a whole, the prior art counsels *directly* against applicants’ invention. This is “strong evidence” of the

nonobviousness of the invention because Goodman teaches a solution that is the *opposite* of the invention of the present application. “[M]atter in the prior art which counsels against doing what the inventor did is strong evidence that the inventor’s solution is not obvious.” Johnson & Son, Inc. v. Gillette Co., 1989 WL 87374, *42, Civ. A. Nos. 83-2657-N, 83-3201-N, (D. Mass. 1989). Therefore, applicants respectfully submit that Goodman must be considered in its entirety, and, when Goodman is considered in its entirety, Goodman teaches away from the claimed invention. As a result, a rejection of the pending claims on the basis of any combination involving Goodman is improper, and for this reason alone, a *prima facie* case of obviousness has not been established.

b. Failure to Establish a Prima Facie Rejection - All Claim Limitations are not Taught or Suggested

Goodman, taken alone or in combination with Smith and applicants’ allegedly admitted prior art, does not teach or suggest all of the claim limitations of the present invention. Namely, because Goodman teaches a single, dedicated processor responsible for handling a system management interrupt, Goodman fails to teach or suggest that **each** processor of the multiple processors is operable to process a system management interrupt and **none** of the processors are dedicated to processing system management interrupts. Additionally, applicants’ allegedly admitted prior art fails to remedy this deficiency, as the cited portions of the Background of applicants’ Specification discuss how, in a multi-processor system, a second processor may be *unable* to properly process a system management interrupt. (Specification, p.4, lines 18-22) Finally, Smith also fails to remedy the deficiencies of Goodman and applicants’ allegedly admitted prior art, as Smith fails to even discuss system interrupts. Thus, because the combination of references fails to teach or suggest all of the claim limitations of the present invention, a *prima facie* case of obviousness has not been established.

II. Request for Relief from Errors

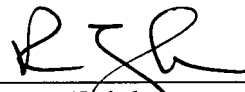
As a *prima facie* obviousness rejection has not been established against applicants’ claims, applicants respectfully request allowance of all pending claims.

CONCLUSION

For the reasons presented above, applicants respectfully request relief from the Errors of Record. If the PTO deems that an interview is appropriate, applicants would appreciate the opportunity for such an interview.

To the extent necessary, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0383 (matter no. 016295.0624).

Respectfully submitted,



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